

REMARKS

I. Introduction

In response to the Office Action dated May 15, 2007, Applicants have amended claims 1 – 17, 19, and 20, and have canceled claims 18 and 21 – 32. No new matter has been added. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that all pending claims are in condition for allowance.

II. Information Disclosure Citation (PTO 1449)

Applicants would like to thank the Examiner for providing a signed copy of the submitted Information Disclosure Citations. However, the Examiner has not acknowledged USP 5,258,985 by providing the Examiner's initials next to this citation. Applicants respectfully request acknowledgement of this reference.

III. Claim Objections

Applicants have amended claims 1 – 17, 19, and 20 to overcome the claim objections. Claims 18 and 21 – 32 have been canceled. Accordingly, withdrawal of all pending claim objections is respectfully requested.

IV. Claim Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,930,271 to Takahashi. Claims 2 and 4 – 9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takahashi in view of U.S. Patent No. 5,386,423 to Koo. Claims 16 – 20, 23 – 26, and 29 stand rejected under § 103(a) as allegedly being unpatentable over Takahashi in view of US. Patent No. 6,055,661 to Luk. Claims 10 – 15, 21, and 22 stand rejected under § 103(a) as allegedly being unpatentable over Takahashi and Koo,

and further in view of Negishi. Applicants traverse these rejection for at least the following reasons.

Claim 1 is directed to a functional block for an integrated circuit comprising a test data output circuit for outputting test data responsive to a control signal indicating a test data transmission state. That is, the functional block itself has a test data output circuit which generates and outputs test data.

Takahashi appears to disclose a functional block for testing included in a DUT (a circuit under test). However, a pattern generator (a circuit for generating test data) is provided in the circuit testing apparatus 10 and outside the DUT. Thus, in Takahashi, a functional block is not provided with a test data output circuit, but rather it only receives test data. Thus, Takahashi clearly fails to anticipate claim 1.

Independent claim 16 is directed to a functional block for an integrated circuit comprising a decision result output circuit for receiving test data responsive to a control signal indicating a test data reception state, deciding whether the test data received is correct or erroneous, and outputting a result of the decision. As described above in relation to claim 1, Takahashi appears to disclose performing a functional test for a functional block having received test data.

The functional block recited in claim 16, by contrast, receives test data (data after testing) from another functional block, decides whether the received test data is correct or erroneous, and outputs a decision result. The Examiner correctly acknowledges that Takahashi does not disclose a comparison circuit and relies on Luk to overcome this deficiency. However Luk does not overcome the deficiencies of Takahashi described above. Furthermore, in Luk, a comparison circuit is provided outside a DUT, thereby corresponding to a separate functional block.

Accordingly, as each and every limitation must be disclosed or suggested by the cited prior art references in order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 (see, M.P.E.P. § 2143.03), and the cited references fail to disclose at least the features described above, it is respectfully submitted that independent claim 16 is patentable over the cited references.

Claims 2 – 15, 17, 19, and 20 depend from one of the independent claims. Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all dependent claims are also in condition for allowance.

V. Double Patenting

Applicants have canceled claims 23 – 32. Accordingly, the double patenting rejection is now moot.

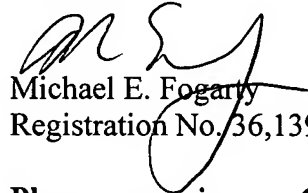
VI. Conclusion

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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